



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

08/311,099 09/23/94 WEISS

S A58103DJ8

18M1/0625

FLEHR HOBBACH TEST ALBRITTON AND HERBERT
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111

ZISEA EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

1804 1804 4

DATE MAILED:

06/23/96

06/25/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire two (2) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-36 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1804

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-31, drawn to a method for determining the effect of at least one biological agent on neural precursor cells, comprising dissociating the cells and contacting the proliferated precursor cells with said biological agent, classified in Class 435, subclass 172.3, for example and Class 435, subclass 240.2, for example.

II. Claims 32-34, drawn to a cDNA library prepared from neural cells, classified in Class 435, subclass 172.3, for example.

III. Claims 32 and 35, drawn to a dna library prepared from neural cells wherein the cells are selected from the group consisting of neurons, astrocytes and oligodendrocytes, classified in Class 435, subclass 172.3, for example.

IV. Claims 32 and 36, drawn to a dna library prepared from neural cells derived from a human afflicted with a neurological disease or disorder, classified in Class 435, subclass 172.3, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions II-IV and Invention I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the products as claimed, the dna libraries derived from different sources can be used in materially different processes such as recombinant production of a particular protein encoded on a gene contained in the library, for example.

Serial Number: 08/311,099

-3-

Art Unit: 1804

Inventions II-IV are independent and distinct products since the genes encoded by the library would be dependent upon those genes being expressed by the differentiated cell types at the time the library was made. Further, the dna libraries encompass recognized divergent subject matter and therefore have separate search requirements.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as evidenced by their different classifications, recognized divergent subject matter and separate search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO FAX center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (30 November 15, 1989). The CM1 Fax Center number is (703) 308-4227.

Serial Number: 08/311,099

-4-

Art Unit: 1804

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Suzanne Ziska, Ph.D., whose telephone number is (703)308-1217. In the event the examiner is not available, the examiner's supervisor, Ms. Jacqueline Stone, may be contacted at phone number (703) 308-3153.


SUZANNE E. ZISKA
PRIMARY EXAMINER
GROUP 1800